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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,722	05/23/2001	John R. Martin	10527US16	2165

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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,722

Applicant(s)

MARTIN ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment / Arguments

1. Applicant's arguments that Castille does not disclose a jukebox, but only jukebox-like functionality has been considered, but is not convincing. The combination of Castille and Cohen are seen to teach the audio/video distribution system claimed.
2. Applicant's amendment of claim 16 is seen to be different in scope to the claim as indicated allowable, thus that indication is removed.
3. Applicant's amendment to claim 22, which removes limitations, rather than adding them is seen to broaden the claims and remains rejected as below.
4. Applicant's challenge to the Official Notice rejections of the previous action do not constitute a proper challenge. Applicant has not specifically pointed out supposed errors in the examiner's action or stated why the noticed features are not common knowledge or well known. The rejection is maintained and the Official Notice is taken to be admitted prior art.

Information Disclosure Statement

5. Applicant is requested to furnish supplemental IDS with copies of foreign and npl references not included with IDS filed 16 December 2002.

Terminal Disclaimer

6. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 16-27 are rejected under the judicially created doctrine of double patenting over claim 1-11 of U. S. Patent No. 6,397,189 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Applicant's amendment to which removes analog/digital converter limitation, is seen to be an obvious variation, since an A/D converter would be necessary to perform the stated invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 22-23, 25-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kirkorian (5,726,909).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille (5,497,502) in view of Cohen (4,949,187) further in view of Verdun (4,667,802) or Tashiro (4,958,835).

As per Claim 16.

Castille ('502) discloses:

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29, images and associated digital song data, see column 1, lines 17-29,

a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);

at least one audio speaker, see figure 1 (17);

a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;

causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed

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compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

Castille ('502) does not disclose a user attract mode wherein song associated images are shown.

Verdun ('802) and Tashiro et al ('835) teach displaying selected graphics when no video selection is playing, see column 1, lines 47-50 of Verdun and column 8, lines 31-54 of Tashiro et al for the benefit of entertaining the user when no video is currently selected.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display song associated images as taught by Verdun and Tashiro et al to attract users.

As per Claim 17.

Castille ('502) does not specifically disclose:

instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor.

Cohen ('187) teaches instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, see column 5, lines 2-7, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor, see column 4, lines 26-29 for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs and store song usage

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data as taught by Cohen ('187) for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

As per Claim 20.

Castille ('502) further discloses communication interface is telecommunication and further the storage of file identity data, see column 4, line 62 – column 5, line 29.

10. Claims 22-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille (5,497,502) in view of Cohen (4,949,187).

As per Claim 22.

Castille ('502) discloses:

- a plurality of computer jukeboxes, capable of playing songs selected by users of the jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, see figure 1 (15) and column 4, lines 1-11;

- a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

- a data storage unit for storing, see column 5, lines 28-29;

- a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

- selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);

- at least one audio speaker, see figure 1 (17);

- a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;

- a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);

- causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

- causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data

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and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

As per Claims 23.

Castille ('502) further discloses bi-directional communications, see figure 1 (2).

As per Claims 25.

Castille ('502) does not specifically disclose the display of the updated list.

Cohen ('187) teaches instructions causing the processor to display the updated library of songs, see column 5, lines 2-7 for the benefit of providing users with convenient access to videos.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs as taught by Cohen ('187) for the benefit of providing users with convenient access to videos.

As per Claims 26.

Castille ('502) does not specifically disclose the storage of usage data.

Cohen ('187) teaches instructions causing the processor to store usage data, see column 4, lines 26-29 for the benefit of ensuring proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store usage data as taught by Cohen ('187) for the benefit of ensuring proper royalty payments.

As per Claim 27.

Castille ('502) discloses:

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29;

a display for showing, to a prospective user, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

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a processor and a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10; and instructions:

causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

11. Claims 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castille (5,497,502) in view of Cohen (4,949,187) in view of Official Notice.

As per Claim 21.

Castille ('502) does not specifically disclose the display is at least 14 inches in diagonal measure.

Official Notice is taken that computer monitors of varying sizes are well known in the computer arts as a matter of user choice.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize a display of at least 14 inches in diagonal measure for reasons of user choice.

As per Claim 24.

Castille ('502) further discloses communications link, see figure 1 (2).

Castille ('502) does not specifically disclose the management station is portable. Official Notice is taken that it is well known to make portable as a design choice. This limitation is seen to be will not distinguish the invention from the prior art in terms of patentability, see *In re Lindberg*, 93 USPQ 23, 25; 194 F2d 732 (CCPA 1952).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to make the management station portable as a design choice.

Action Made Final

12. **THIS ACTION IS MADE FINAL.** Applicant's amendments and submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 16 December 2002 prompted the new ground(s) of rejection presented in this Office action. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'Thomas A. Dixon', with a stylized flourish at the end.

Thomas A. Dixon
Examiner
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February 25, 2003